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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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Paper No. 10  
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Isle of Capri Casinos, Inc.

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Serial No. 75/702,486

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Marsha K. Hoover and Kevin A. Thompson of Davis, Mannix & McGrath for Isle of Capri, Inc.

Andrew J. Benzmilller, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

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Before Hairston, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Isle of Capri Casinos, Inc. has filed a trademark application to register the mark BANANA CABANA for "retail gift shops."<sup>1</sup>

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark BANANA CABANA, previously registered for

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<sup>1</sup> Serial No. 75/702,486, in International Class 35, filed May 11, 1999, based on use in commerce, alleging first use and use in commerce as of August 1992.

"restaurant services,"<sup>2</sup> that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the marks, there is no question that applicant's mark is identical to the registered mark. It is well established that when the marks at issue are the same or nearly so, the goods and/or services in question do

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<sup>2</sup> Registration No. 1,722,752 issued October 6, 1992, to Angie S. and John J. Avinger, in International Class 42. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), "... the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion."

The Examining Attorney contends that applicant's gift shop services are closely related to registrant's restaurant services. In support of his position, the Examining Attorney submitted numerous copies of third-party registrations wherein the same mark is registered for restaurant services and gift shop services and, in some cases, for casino services as well. The Examining Attorney also submitted excerpts from the LEXIS/NEXIS database of articles referring to, in particular, casinos and resorts that house both restaurants and gift shops.

Applicant submitted the declaration of James D. Guay, applicant's vice president of marketing, who states that applicant's services are limited to gift shops located in its casinos; that the gift shops are only advertised within its casinos; that no food items are sold in its gift shops; and that, although applicant has both gift shops and restaurants in its casinos, the restaurants have entirely different names, such as Calypso's, Farradays' and

Tradewinds. Applicant argues that the services are quite different; that the respective services do not appeal to the same market; and that its mark and the registered mark have coexisted for a number of years without any evidence of actual confusion.

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each

parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Despite applicant's contention's regarding the specific manner in which it offers its services within its own casinos, its recitation of services contains no such limitations. Based on the evidence of record, we find that applicant's gift shop services are sufficiently related to restaurant services that, if identified by identical or substantially similar marks, confusion as to source or sponsorship is likely. Applicant's own evidence indicates that it offers both restaurant and gift shop services in its casinos. The fact that applicant presently does so under different marks is not persuasive of a different result herein.

With regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant, we note that, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-1471.

Therefore, we conclude that in view of the identity of applicant's and registrant's marks, their contemporaneous use on the closely related services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

*Decision:* The refusal under Section 2(d) of the Act is affirmed.